REMARKS/ARGUMENTS

Petition is hereby made under the provisions of 37 CFR 1.136(a) for an extension of three months of the period for response to the Office Action. The enclosed cheque includes the prescribed fee.

The Examiner considered the oath or declaration to be defective having regard to the non-initiated and/or non-dated alterations with respect to the Post Office Address of Mary E. Ewasyshyn. A substitute Declaration will follow.

The Examiner indicated that applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 USC 120. The reference to related applications on page 1 has been expanded to include the filing date of the PCT application and to include the continuation status with respect of US Application No. 09/262,927 and its precursor applications. It is submitted that the conditions to receive the benefit of priority have been met.

The Examiner objected to claim 1 since the term "RSV" should be spelled out at the first occurrence of the term. Claim 1 has been amended in this regard.

The Examiner objected to claim 17 because of a spelling error. Claim 17 has been deleted.

The Examiner rejected claims 1 to 24 under 35 USC 112, first paragraph, on the basis of enablement. The claims of the application have been amended to refer to a plasmid vector, for which the Examiner indicated there to be enablement. It is submitted that claims 1 to 24, insofar as they remain in the application and in their amended form, are now fully enabled and hence the rejection thereof under 35 USC 112, first paragraph, on this ground, should be withdrawn.

The Examiner rejected claims 1, 3 to 9 and 11 to 12 under 35 USC 102(b) as being anticipated by Li et al.

As noted above, applicant has satisfied the conditions for priority from US Patent Application No. 09/262,927 filed March 5, 1999. As such, the Li et al reference is not citable under 35 USC 102(b). Accordingly, the rejection of claims 1, 3 to 9 and 11 to 12 under 35 USC 102(b), as being anticipated by Li et al, should be withdrawn.

However, the reference may be relevant to a rejection under 35 USC 102(a). The applicants hereby file a Declaration under 37 CFR 1.131, indicating that the invention which is the subject matter of this application was made prior to effective date of the reference and that the non-inventor authors of the Li et al are not inventors of the subject matter hereof.

It is noted that the Examiner relies on the last sentence of the first incomplete paragraph of the right hand column on page 684 of the Li et al reference. For the statement in that sentence to be made, it is self-evident that the experimental results described there and the constructs utilized to generate such results existed prior to the publication of the article. To the extent such statement is relevant to the subject matter hereof, then the invention of the subject matter of the rejected claims was in existing prior to the date of the reference.

An unsigned copy of the Declaration is enclosed. The signed copy will follow.

Accordingly, it is submitted that Li et al is not citable prior art under 35 USC 102(a).

The Examiner rejected claims 1 to 2, and 13 to 24 under 35 USC 103(a) as being unpatentable over Li et al (J. Exp. Med.) in view of Li et al (WO 99/04010) and Lee et al. As demonstrated above, the Li et al (J. Exp. Med.) reference is not citable under 35 USC 102(a) or (b) and hence cannot form the basis for this rejection under 35 USC 103(a).

Accordingly, it is submitted that the rejection of claims 1 to 2 and 13 to 24 under 35 USC 103(a) as being unpatentable over the cited combination of prior art, should be withdrawn.

The Examiner rejected claims 1 to 24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 25 of US Patent No. 6,083,925.

The claims of US Patent No. 6,083,925 are directed to a method of immunizing (claims 1 to 10), a method of using a gene (claims 11 to 19) and a method of making a vaccine (claims 20 to 24). Claims 12 to 24 have been deleted from this application, directed to claims of the same type.

Remaining in this application are claims to a plasmid vector (claims 1 to 10) and to an immunogenic composition (claim 11). Claims of this type are not found in US Patent No. 6,083,925. It is submitted that this is a clear line of demarkation of claimed subject matter and that the claimed subject matter is not an obviousness-type double patenting of the claims of US Patent No. 6,083,925.

It is submitted that the rejection of claims 1 to 24, insofar as they remain in this application, under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 25 of US Patent No. 6,083,925, should be withdrawn.

The Examiner also rejected claims 1 to 24 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7 of US Patent No. 6,486,135.

The claims of USP 6,486,135 are directed to a method of using a gene. Claims of this type have been deleted from this application and, as noted above, the remaining claims establish a clear line of demarkation of claimed subject matter. Accordingly, it is submitted that the rejection of claims 1 to 24, insofar as they remain in the application, under judicially-created doctrine of obviousness-type

double patenting over claims 1 to 7 of US Patent No. 6,486,135, should be withdrawn.

It is believed that this application is now in condition for allowance and early and favourable consideration and allowance are respectfully solicited.

Respectfully submitted,

Michael I. Stewart
Reg. No. 24,973

Toronto, Ontario, Canada,
(416) 595-1155
FAX No. (416) 595-1163